

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Gilad Israel Elbaz et al.	Art Unit :	2129
Patent No. :	7,925,610	Examiner :	Peter D. Coughlan
Issue Date :	April 12, 2011	Conf. No. :	2189
Serial No. :	10/690,328		
Filed :	October 21, 2003		
Title :	DETERMINING A MEANING OF A KNOWLEDGE ITEM USING DOCUMENT BASED INFORMATION.		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)(3)
TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

Patentees hereby petition under 37 C.F.R. § 1.181(a)(3) to invoke the supervisory authority of the Director in response to a Final Agency Decision on Request for Reconsideration of Decision on Application for Patent Term Adjustment (“the Decision”) mailed by the Office of Petitions on September 13, 2011.

The Decision maintained that the present patent is entitled to 272 days of Patent Term Adjustment (PTA). Patentees request that the Director review the Decision as well as the remarks presented herein and modify the PTA calculation to 399 days, or hold a final decision in abeyance pending the final resolution of the litigation in Abbott Biotherapeutics Corp. v. Kappos.

I. Pending Civil Action in the U.S. District Court for the District of Columbia

The legal issue presented in this petition is currently the subject of a civil action against the USPTO in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). The plaintiff in Abbott Biotherapeutics Corp. v. Kappos has argued that the USPTO improperly calculated the length of the statutory delay period defined by 35 USC 154(b)(1)(B) by subtracting from the delay period the number of days from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). In the event that the USPTO is unwilling to increase PTA for the present patent in the manner requested herein, Patentees request that a final decision on this petition be held in abeyance pending the final resolution of the litigation in Abbott Biotherapeutics Corp. v. Kappos. A decision in Abbott

Biotherapeutics Corp. v. Kappos will likely settle the legal issue that is central to the present petition.

II. Patent Term Adjustment Using the Plain Language of 35 U.S.C. § 154(b)(1)(B)

Section 154(b)(1)(B) of Title 35 guarantees no more than three-year application pendency ("B Delay"). Failure of the Office to issue a patent within 3 years after the actual filing date of the application in the United States results in the extension of the term of the patent by 1 day for each day after the end of that 3-year period until the patent is issued. Thus, if the Office does not issue a patent within three years of an application being filed, the patentee will be compensated for processing delays incurred by the Office.

Under 35 U.S.C. § 154(b)(1)(B)(i)-(iii) the statute specifically excludes three categories of time from the three-year pendency period: (1) any time consumed by continued examination of the application requested by the applicant, (2) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court, and (3) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant.

The Office has enacted an interpretation of 35 U.S.C. § 154(b)(1)(B)(i) that contradicts the plain language of the statute. The statute excludes "time consumed by continued examination of the application." The Office has calculated three-year pendency incorrectly by excluding time not consumed by continued examination. Specifically, the Office has excluded time beginning on the date of the mailing of the Notice of Allowance, and ending on the date the patent was issued. By mailing a Notice of Allowance, the PTO closes examination of the application on that date. Also, this period of time should not be considered a period of "continued examination," as this period of time is consumed regardless of whether the patent is issued after a Request for Continued Examination has been filed or not. Thus, the Office has improperly limited the period of three-year pendency by its interpretation of the statute.

In the instant case, Patentees submit that B Delay accumulated for a total of 1,634 days, beginning on October 22, 2006 (the day after the date that is three years after the date on which the application was filed), and ending April 12, 2011 (the date the patent was issued). The Office has excluded from B Delay the number of days corresponding to the period beginning on April 23, 2007 (the date on which a Request for Continued Examination was first filed) and ending on April 12, 2011 (the date the patent was issued). However, this entire period should not be excluded from B Delay because it does not correspond exactly to continued examination. The Examiner's mailing of a Notice of Allowance on December 7, 2010, closed examination of the application on that date. Thus, no continued examination took place during the 127 day period from December 7, 2010 (the mailing date of the Notice of Allowance), until April 12, 2011 (the date the patent was issued). Accordingly, 127 days of B Delay should have been included in addition to the 183 days accorded by the Director, for a total B Delay of 310 days. Patentees respectfully submit that the Office's calculation of "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 310 days.

III. Conclusion and Statement of Patent Term Adjustment

For the reasons detailed herein, the Office erred in the calculation of patent term adjustment by excluding time under Section 154(b)(1)(B)(i) of Title 35. Section 154(b)(1)(B)(i) of Title 35 excludes from B Delay "time consumed by continued examination of the application." The statute does not provide for exclusion from B Delay of time from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). Accordingly, 127 days of B Delay should have been assessed from December 7, 2010 (the mailing date of the Notice of Allowance), until April 12, 2011 (the date the patent was issued).

Patentees request reconsideration of the patent term adjustment in the following manner:

- 1) Total Office Delay should be calculated as 830 days (i.e., the sum of 520 days of "A Delay" and 310 days of "B Delay");
- 2) Total Applicant Delay is 431 days; and

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3) Total Patent Term Adjustment should be calculated as 399 days.

No fee is believed due. However, if any fee is due, please charge it to Deposit Account
No. 06-1050, referencing Attorney Docket Number 16113-0328001.

Respectfully submitted,

Date: November 14, 2011

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